

DOCKET NO: 271730US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
MICHEL STREBELLE, ET AL. : EXAMINER: KEYS, ROSALYND ANN
SERIAL NO: 10/534,299 :
FILED: MAY 9, 2005 : GROUP ART UNIT: 1621
FOR: PROCESS FOR THE :
MANUFACTURE OF 1,2-EPOXY-3-
CHLOROPROPANE

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is a Reply in response to the Examiner's Answer dated April 29, 2008.

Applicants repeat the arguments for patentability made in their Brief, which are incorporated herein by reference.

REPLY

The Examiner continues to misapprehend the evidentiary effect of unexpected results. In her understanding, if she believes that she has made a *prima facie* case, no results provided by the invention could possibly be unexpected because they "flow naturally from following the suggestion of the prior art" (Section (10) 8) of the Examiner's Answer) or because "any advantages that result in the instant process would also result in the combination of [the prior art references]" (Section (10) 9) of the Examiner's Answer) or because "the prior art references when combined ... would inherently overcome the reduced

catalyst life problem relied upon by Applicants for patentability” (Section (10) 10) of the Examiner’s Answer). In essence, the Primary Examiner fails to understand the role of rebuttal evidence.

As the Board is well aware, it is legal error for the Office to dismiss a showing of unexpected results as flowing from or inherent in the Examiner’s prior art construct (in this case, the combination of Takehisa and Strebelle). As stated in In re Sullivan, 84 USPQ2d 1034 (Fed. Cir. 2007):

It is well settled that the PTO “bears the initial burden of presenting a prima facie case of unpatentability.... However, when a prima facie case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability.” *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002). Rebuttal evidence is “merely a showing of facts supporting the opposite conclusion.” *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Evidence rebutting a prima face case of obviousness can include: “evidence of unexpected results,” *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1369 (Fed. Cir. 2007), evidence “that the prior art teaches away from the claimed invention in any material respect,” *In re Peterson*, 315 F.3d 1325, 1331 (Fed. Cir. 2003), and evidence of secondary considerations, such as commercial success and long-felt but unresolved needs, *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1359 (Fed. Cir. 1999). When a patent applicant puts forth rebuttal evidence, the Board must consider that evidence. See *In re Soni*, 54 F.3d 746, 750 (Fed. Cir. 1995) (stating that “all evidence of nonobviousness must be considered when assessing patentability”); *In re Sernaker*, 702 F.2d 989, 996 (Fed. Cir. 1983) (“If, however, a patent applicant presents evidence relating to these secondary considerations, the board must always consider such evidence in connection with the determination of obviousness.”).

Rather than considering Applicants’ showing of unexpected results as rebuttal evidence to an alleged *prima facie* case, the Examiner has dismissed it and, in fact, has clearly convinced herself (and apparently two SPEs) that unexpected results cannot exist when she thinks she has made a *prima facie* case. This is clear legal error.

In addition to their showing that there is no *prima facie* case, Applicants have shown an unexpected improvement in catalyst life. The Examiner has put forth no reasoning that would support a conclusion that, *looking forward*, such an improvement would have been

expected from the combination of Takehisa and Strebelle. Rather, the Examiner looks backwards and concludes that because it is her opinion that the references present a *prima facie* case any property, benefit, or characteristic of the invention Applicant wishes to discuss in rebuttal is meaningless. As the Board is aware, this is completely improper and, at best, is a classic case of requiring comparison of the results of the invention with the results of the invention. See MPEP 716.02(e) and *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966). On this point alone the Examiner should be REVERSED.

As noted above in In re Sullivan, another source of rebuttal evidence is “evidence ‘that the prior art teaches away from the claimed invention in any material respect.’” In this case the 1998 article by Sheldon describes Takehisa’s catalysts as ineffective with Strebelle’s peroxide: in Sheldon the catalyst used by Takehisa is described as *noneffective* when combined with Strebelle’s aqueous hydrogen peroxide.

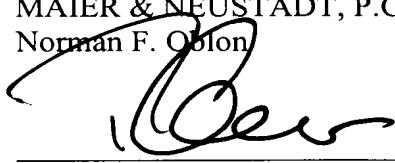
The Examiner has responded to this argument by explaining that she is only reaching into Strebelle for its reactant allyl chloride, but this misses the mark. First, the reference stands as a whole, and given the teaching in the art away from the combination of Takehisa and Strebelle, one would not pick and choose selected parts of contrary references for combination. Second, the Final rejection makes it clear that the rejection being appealed *is* based upon the use of Takehisa’s catalyst with the Strebelle peroxide: see page 3, 4th paragraph of the Final rejection (“One having ordinary skill in the art ... would have found it obvious to substitute hydrogen peroxide, as taught by Strebelle et al. for the alkyl peroxides of Takehisa ...”). Regardless of the Examiner’s theory, the article by Sheldon describes Takehisa’s catalysts as ineffective with Strebelle’s peroxide, thus teaching away from the combination of these references.

Accordingly, and for the reasons presented above and in their principle Brief, it is respectfully requested that the rejection be REVERSED.

Respectfully submitted,

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